UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/721,894	11/25/2000	Kia Silverbrook	NPA061US	4082

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AUSTRALIA

EXAMINER
HUYNH, THU V

ART UNIT	PAPER NUMBER
2178	

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

	Application No.	Applicant(s)
Office Action Summary	09/721,894	SILVERBROOK ET AL.
	Examiner	Art Unit	
	Thu V Huynh	2178	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>14 March 2005</u>.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1 and 4-32* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1 and 4-32* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)

2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date *1/18/05*.

4)☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ .

5)☐ Notice of Informal Patent Application (PTO-152)

6)☐ Other: _____ .

DETAILED ACTION

1.   This action is responsive to communications: IDS filed on 1/18/2005 and amendment

filed on 03/14/2005 to application filed on 11/25/2000 which has foreign priority filed on

02/24/2000.

2.   Claims 1 and 17 are amended.

3.   Claims 1, 4-17, 19-32 are pending in the case. Claims 1 and 17 are independent claims.

4.   All rejections in previous office action have been withdrawn in view of the amendment.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

(b) This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6.   **Claims 1, 4-12, 14, 17, 19, 20, 22, 24-26, 28-29, 32 are rejected under 35 U.S.C.**

103(a) as being unpatentable over <u>Bergelson</u> et al., US 6,697,056 B1, filed 01/2000, in view

of <u>Dymetman</u> et al., "Intelligent Paper", pages 392-460, Proceedings of EP '98,

March/April 1998, as supplied by the applicants in IDS filed 05/20/2004, and <u>Wright</u> et al.,

US 4,864,618, patented 1989, as supplied by the applicants in IDS filed on 01/18/2005.

Regarding independent claim 1, Bergelson teaches a method of capturing, in computer

system, data relating to a note-taking session, the session consisting of handwritten annotations

made by a user by way of a writing implement on a plurality of printed paper pages (Bergelson,

abstract, col.2, lines 47-67; col.3, lines 32-49; a computer system allow users input handwritten,

note, marks into printed paper forms/pages to fill the forms/page), each of the plurality of pages

including coded data indicative of an identity of the page (Bergelson; col.3, lines 12-19; each

form/page includes coded data to indicative the identity of the form/page) and of a plurality of

reference points on the page, the coded data identifying a unique location of each of the

reference points relative to the page (Bergelson, col.2, lines 1-22; col.3, line 50 – col.4, lines 4;

col.6, lines 41-62; each form/page includes plurality of data fields, the coded data identifying a

unique form and data fields of the form; "ink data" references to "the image and location of the

form identifier, along with image and location data for any other information written on the form

by a user"), the method including the steps of:

- receiving, in the computer system and via the writing implement, an indication of the

    start of the note-taking session (Bergelson, col.2, lines 47-67; col.3, lines 32-49;

    receiving in the computer system and via writing implement, such as a special pen, an

    indication to start a filling forms/pages);

- receiving, in the computer system and via the writing implement interacting with the

    printed paper pages, data indicative of said handwritten annotations made by said user

    on said plurality of printed paper pages (Bergelson, col.2, lines 47-67; col.3, lines 32-

    49; receiving in the computer system and via writing implement, such as a special

pen, handwritten annotations made by a user on plurality of printed paper

forms/pages);

- receiving, in the computer system and via the writing implement, an indicative of the

end of the note-taking session (Bergelson, col.2, lines 47-67; col.3, lines 32-49;

receiving in the computer system via writing implement, such as a special pen, an

indication to upload the form when finishing filling the form); and

- retaining a retrievable record of the received data of the note-taking session

(Bergelson, col.2, lines 47-67; col.3, line 32 – col.4, line 4; storing and loading the

filling form to a person computer).

However, Bergelson does not explicitly teaches the paper including invisible coded data

in the form of tags and wherein the visible graphic data and the invisible coded data are printed

by the same printer and at the time of printing the computer system associated the type and

spatial extent of each tag of the coded data with the spatial extent of at least some of the graphic

data.

Dymetman teaches intelligent paper including visible graphic data and invisible coded

data in the form of tags indicative of an identity of the page and of a plurality of reference points

relative on the page, the coded data identifying a unique location of each of the reference points

relative to the page, and at the time of printing the computer system associated the type and

spatial extent of each tag of the coded data with the spatial extent of at least some of the graphic

data (Dymetman, pages 393 and 396, last paragraphs; printing visible graphic data layer on a

invisible coded data which includes page-id and pointer-loc via mark printed).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Dymetman into Bergelson to include intelligent paper, since the combination would have allow the system to work with different kinds of form as suggested by Bergelson in col.2, lines 54-62.

Wright teaches visible graphic data and invisible coded data are printed by the same printer and at the time of printing the computer system associates the invisible coded data with the visible graphic data (Wright, col.12, lines 47-64; col.13, lines 23-31; a printer with two ink ribbons to print invisible and visible data on a paper).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wright into Dymetman and Bergelson to include a printer which has two ink ribbons as Wright disclosed, since the combination would have allow the printing system to print both visible and invisible data on a paper.

Regarding claim 4, which is dependent on claim 1, Bergelson teaches wherein the coded data being substantially invisible in the visible spectrum (Bergelson, col.2, lines 1-22; col.3, line 50 – col.4, lines 4; col.6, lines 41-62).

Regarding dependent claim 5, which is dependent on claim 1, Bergelson teaches wherein said indication of the start of the note-taking session is provided by the computer system receiving data indicative of said handwritten annotations made by said user on said plurality of printed paper pages (Bergelson, col.2, lines 47-67; col.3, lines 32-49).

Regarding claim 6, which is dependent on claim 1, Bergelson teaches wherein said

plurality of printed paper pages are associated with a control portion comprising at least one

control zone, the computer system receiving an indication via said writing implement that said

user has designated one or more control zones using writing implement (Bergelson, col.3, lines

12-49; using the special pen to enter form identification and/or forward/backward forms/pages).

Regarding claim 7, which is dependent on claim 6, Bergelson teaches wherein one or

more of said printed paper pages includes said control portion (Bergelson, col.3, lines 12-49;

using the special pen to enter form identification and/or forward/backward forms/pages).

Regarding claim 8, which is dependent on claim 6, Bergelson teaches wherein said

plurality of printed paper pages is provided in the form of a notepad and the notepad includes

said control portion on a part of the notepad other than on one of said pages (Bergelson, col.1,

lines 29-35; col.2, lines 47-67; col.3, lines 12-49; using the special pen to enter form

identification and/or forward/backward forms/pages on a CrossPad).

Regarding claim 9, which is dependent on claim 6, Bergelson teaches wherein said at

least one control zone includes a zone associated with the start of the note-taking session, and

said indication of the start of the note-taking session is provided by the computer system

receiving an indication that said user has designated zone by way of said writing implement

(Bergelson, col.2, lines 47-49; col.3, lines 12-49; using the special pen to enter form

identification forms/pages on a CrossPad to start filling the forms/pages).

Regarding claim 10, which is dependent on claim 6, Bergelson teaches wherein said at least one control zone includes a zone associated with the end of the note-taking session, and said indication of the end of the note-taking session is provided by the computer system receiving an indication that said user has designated zone by way of said writing implement (Bergelson, col.2, lines 47-67; col.3, lines 32-49; receiving in the computer system via writing implement, such as a special pen, an indication to upload the form when finishing filling the form).

Regarding claim 11, which is dependent on claim 1, Bergelson teaches wherein said writing implement includes a writing nib and said writing nib is associated with a sensor able to detect nib contact with one of said plurality of printed paper pages (Bergelson, col.1, lines 29-35; a sensor must be included to detect pen movements on the forms/pages).

Regarding claim 12, which is dependent on claim 1, Bergelson teaches storing the filled form from a Crosspad to a computer hard drive (Bergelson, col.3, lines 20 and col.4, lines 5-10). Bergelson does not explicitly disclose the step of using said retrievable record to selectively print the data indicative of said handwritten annotation.

However, printing a stored file from a hard drive was well known feature.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included a printer into Bergelson's computer system to print filled

forms, since including a printer into a computer system was well known in the art to print files

stored in a computer.

Regarding claim 14, which is dependent on claim 12, Bergelson teaches storing the

filled form from a Crosspad to a computer hard drive (Bergelson, col.3, lines 20 and col.4, lines

5-10). Bergelson does not explicitly disclose wherein the data being printable on a plurality of

printed paper pages corresponding to the plurality of pages annotated in the note-taking session.

However, printing a stored file from a hard drive was well known feature.

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have included a printer into Bergelson's computer system to print filled

forms, since including a printer into a computer system was well known in the art to print files

stored in a computer.

Regarding claim 19, which is dependent on claim 17, Bergelson teaches wherein each

printed paper page includes coded data indicative of an identity of the page, and said indicating

data regarding both the position of the writing implement relative to a page and the identity of

the page (Bergelson, col.2, lines 1-22; col.3, lines 12-49).

Regarding claim 32, which is dependent on claim 17, Bergelson teaches storing the

filled form from a Crosspad to a computer hard drive and form identifiers in a storage

(Bergelson, col.3, lines 20 and col.4, lines 5-10). Bergelson does not explicitly disclose

including a printer for printing the coded data on the plurality of pages.

However, printing a stored file from a hard drive or storage in a computer was well known feature.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have included a printer into Bergelson's computer system to print filled forms, since including a printer into a computer system was well known in the art to print files stored in a computer.

Claims 17, 20, 22, 24-26, 28-29 are for a computer system performing the method of claims 1, 4, 11, 6-8, 9-10, respectively and are rejected under the same rationale.

7.   **Claim 13 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergelson in view of Dymetman and Wright as applied to claims 12 and 24 above, and further in view of Moran et al., US 5,717,879, patented 1998.**

Regarding claim 13, which is dependent on claim 12, plurality of printed paper pages are associated with a control portion comprising at least one control zone, the computer system receiving an indication via said writing implement that said user has designated one or more control zones using writing implement (Bergelson, col.3, lines 12-49; using the special pen to enter form identification and/or forward/backward forms/pages). Bergelson does not explicitly teach wherein said plurality of printed paper pages is associated with a control portion including a zone associated with the printing of the note-taking session, the computer system receiving an indication via said writing implement that said user has designated said zone using the writing implement.

Moran teaches a control portion including a zone associated with the printing of the note-taking session, the computer system receiving an indication via said writing implement that said user has designated said zone using the writing implement (Moran, fig.15 "print" command).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have include a zone associated with the printing of note-taking section into Bergelson's system, since the combination would have printed a note-taking from Crosspad's control zone.

Claim 30 is for a computer system performing the method of claim 13 and is rejected under the same rationale.

8.   **Claims 15 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bergelson in view of Dymetman and Wright as applied to claims 14 and 30 above, and further in view of Tonkin et al., US 6,616,702 B1, priority filed 1998.**

Regarding claim 15, which is dependent on claim 14, Bergelson does not explicitly disclose binding plurality of printed pages.

Tonkin teaches a system allows a user specifies a binding type via stylus to binding plurality of printed pages (Tonkin, col.2, lines 43-63; col.4, lines 63-67; and col.10, lines 35-49).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Tonkin and Bergelson to bind plurality of printed pages of a document together, since this would have offered features for the print function.

Claim 31 is for a computer system performing the method of claim 15 and is rejected under the same rationale.

9.   **Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over <u>Bergelson in view of Dymetman and Wright</u> as applied to claims 1 and 17 above, and further in view of <u>Wolff</u> et al., US 6,081,261, filed 1995, and <u>Moran</u> et al., US 5,717,879, patented 1998.**

Regarding claim 16, which is dependent on claim 1, Bergelson does not explicitly disclose that the writing implement contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user in said note-taking session and in which the method includes monitoring, in the computer system, said identity.

Wolff teaches that a writing implement contains an identification means which imparts a unique identity to the sensing device and identifies it as being associated with a particular user in said note-taking session (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; and col.10, lines 34-38).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have combined Wolff into Bergelson to provide an identification means to identify user who takes note on the forms, note book or documents, since the combination would have distinguished entries from different users as Wolff disclosed in col.10, lines 34-38.

Wolff does not explicitly disclose monitoring said identity in the computer system.

Moran teaches tracking color coded to identify the person in a meeting who annotated on

a whiteboard and playing back the meeting session (Moran, col.3, lines 12-23; col.5, lines 19-33

and col.22, lines 8-21)

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Moran into Wolff and Bergelson to identify persons

during annotation/filling session, since this would have supported workgroup meeting using pen

based annotation environment.

10.   **Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over** Bergelson in

view of Dymetman and Wright **as applied to claim 17 as explained above, and further in**

view of Wolff **et al., US 6,081,261, filed 1995.**

Regarding claim 21, which is dependent on claim 17, Bergelson teaches a writing

implement which includes sensor for detecting said coded data.

Wolff teaches annotating a document using writing implement, the document includes

coded data page identification, and writing implement includes a sensor for detecting said code

data (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; col.4, lines 7-12; and

col.4, lines 7-12 and lines 52-58).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Wolff and Bergelson to provide an input device that

include a sensor for recognizing coded data identification, since this would have offer

Bergelson's system to use bar code for identify forms or document pages as Wolff disclosed.

11.   **Claims 23 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over**

Bergelson in view of Dymetman Wright and Wolff as applied to claim 21 as explained

above, and further in view of **Moran** et al., US 5,717,879, patented 1998.

Regarding claim 23, which is dependent on claim 21, Bergelson does not explicitly

disclose that the writing implement contains an identification means which imparts a unique

identity to the sensing device and identifies it as being associated with a particular user in said

note-taking session and in which the method includes monitoring, in the computer system, said

identity.

Wolff teaches that a writing implement contains an identification means which imparts a

unique identity to the sensing device and identifies it as being associated with a particular user in

said note-taking session (Wolff, col.1, line 62 – col.2, line 2; col.2, line 43 – col.3, line 11; and

col.10, lines 34-38).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Wolff into Bergelson to provide an identification means

to identify user who takes note on the forms, note book or documents, since the combination

would have distinguished entries from different users as Wolff disclosed in col.10, lines 34-38.

Wolff does not explicitly disclose monitoring said identity in the computer system.

Moran teaches tracking color coded to identify the person in a meeting who annotated on

a whiteboard and playing back the meeting session (Moran, col.3, lines 12-23; col.5, lines 19-33

and col.22, lines 8-21)

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Moran into Wolff and Bergelson to identify persons

during annotation/filling session, since this would have supported workgroup meeting using pen

based annotation environment.

Regarding claim 27, which is dependent on claim 26, Bergelson does not explicitly

disclose said plurality of pages being superposed and joined together on a backing sheet, the

backing sheet sized to extend beyond at least one edge of the superposed plurality of pages to

provide an uncovered extended part, said control portion being provide on said extended part of

the backing sheet.

Moran teaches annotation on plurality of pages that being superposed and joined together

on a backing sheet, the backing sheet sized to extend beyond at least one edge of the superposed

plurality of pages to provide an uncovered extended part, said control portion being provide on

said extended part of the backing sheet (Morran, col.3, lines 13-23; col.25, lines 10-23; col.14,

lines 25-47; and fig.15, annotations documents on an electronic whiteboard).

It would have been obvious to a person of ordinary skill in the art at the time the

invention was made to have combined Moran and Bergelson to annotate documents in a meeting

environment, since whiteboard is used in record and playback annotation portion.

Response to Arguments

12.   Applicant's arguments with respect to claims 1, 4-17, 19-32 have been considered but are

moot in view of the new ground(s) of rejection.

Applicants argue that with respect to claims 1 and 17 that Bergelson "does not disclose the use of position-identifying coded data that are stored in a computer system and printed on a page by a printer".

However, the combination of Bergelson, Dymetman and Wright teaches the amended claims 1 and 17 as explained in the rejection above.

Applicants argue that Dymetman's Intelligent Paper "that requires manual association between a page-id and visible graphic data printed on the page is different from the Netpages disclosed in the present application . . . the present invention enables and automatic association between coded data including an identity or a page and graphic data printed on the page. Such automatic association is possible because the same printer prints both the coded data and the graphic data".

This is not persuasive. Dymetman teaches printing visible graphic data overlay on invisible code data (Dymetman, pages 393 and, last paragraphs). This perfectly matches with what applicants claimed, since in order to joint two layers, visible and invisible data, such layers must be associated together.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thu V Huynh whose telephone number is (571) 273-4126. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, Stephen S Hong can be reached on (571) 273-4124. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

Application Information Retrieval (PAIR) system. Status information for published applications

may be obtained from either Private PAIR or Public PAIR. Status information for unpublished

applications is available through Private PAIR only. For more information about the PAIR

system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

TVH
March 28, 2005

STEPHEN HONG
SUPERVISORY PATENT EXAMINER